

### **REMARKS**

Applicants respectfully request entry of the following amendments and remarks in response to the Final Office Action mailed August 3, 2009. Applicants respectfully submit that the amendments and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 1, 2, and 4 – 21 are pending. In particular, Applicants add claims 21, amend claims 1, 10, and 13, and cancel claim 3 without prejudice, waiver, or disclaimer. Applicants cancel claim 3 merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

#### **I. Rejections Under 35 U.S.C. §103**

##### **A. Claim 1 is Allowable Over *Hickey*, *Heyen*, and *Friskel***

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Publication Number 2002/0087646 ("*Hickey*") in view of U.S. Patent Number 5,093,918 ("*Heyen*"), and further in view of U.S. Patent Number 6,839,737 ("*Friskel*"). Applicants respectfully traverse this rejection for at least the reason that *Hickey* in view of *Heyen* and *Friskel* fail to disclose, teach, or suggest all of the elements of claim 1. More specifically, claim 1 recites:

A communication system comprising:

a client-side group email folder accessible by each user in a predefined group of users;

a group email message in the client-side group email folder that is provided by an email application, the group email message having indicators, each indicator corresponding to a user in the predefined group of users, each indicator being configured to indicate whether the corresponding user has acted upon the group email message; and

an instant messaging application that is linked with the email application, the instant messaging application being associated with a common account as the email application, ***wherein the system is configured to provide an interface that includes a single user-selectable option for a user to select whether predetermined presence data for both the email application and the instant messaging application is sent to email recipients,***

wherein the group email message is stored in a common database such that the users in the predefined group of users have access to the group email message via the database,

wherein the communication system is configured to provide an email interface for providing the group email message and an option to view at least one user-specific email, the user-specific email being different than the group email message.

***(Emphasis added).***

Applicants respectfully submit that claim 1, as amended, is allowable over the cited art for at least the reason that none of *Hickey*, *Heyen*, and *Friskel*, taken alone or in combination, discloses, teaches, or suggests a "communication system... ***wherein the system is configured to provide an interface that includes a single user-selectable option for a user to select whether predetermined presence data for both the email application and the instant messaging application is sent to email recipients***" as recited in claim 1. More specifically, the Office Action admits "*Hickey* and *Heyen* disclose the claimed invention except for... wherein the system is configured to provide an interface that includes a single option to determine presence data for both the email application and the instant messaging application" (OA page 4, line 7).

Further, *Friskel* fails to overcome the deficiencies of *Hickey* and *Heyen*. More specifically, *Friskel* discloses a "sender status column 308 to indicate the on-line status of each

sender of an e-mail using status indicators 310" (column 5, line 9). However, this deals with an indicator that is provided to an email recipient. Consequently, this is completely different than a "communication system... ***wherein the system is configured to provide an interface that includes a single user-selectable option for a user to select whether predetermined presence data for both the email application and the instant messaging application is sent to email recipients***" as recited in claim 1. For at least these reasons, claim 1, as amended, is allowable.

**B. Claim 10 is Allowable Over Hickey, Heyen, and Friskel**

The Office Action indicates that claim 10 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Publication Number 2002/0087646 ("*Hickey*") in view of U.S. Patent Number 5,093,918 ("*Heyen*"), and further in view of U.S. Patent Number 6,839,737 ("*Friskel*"). Applicants respectfully traverse this rejection for at least the reason that *Hickey* in view of *Heyen* and *Friskel* fail to disclose, teach, or suggest all of the elements of claim 10. More specifically, claim 10 recites:

A communication method comprising:  
providing indicators in a group email message, the group email message being provided to a predefined group of users, each indicator corresponding to one of the users in the predefined group of users, each indicator having a setting, each indicator configured to indicate whether the corresponding user has acted upon the group email message;

changing the setting of one indicator in response to the email message being acted upon by its corresponding user; and

providing, by an email application, an interface for providing the group email message and an option to view at least one user-specific email, the user-specific email being different than the group email message, the interface including an instant messaging interface for a common account as the email application, ***wherein providing an interface includes providing a single user-selectable option for a user to select whether predetermined presence data for both the email application and the instant messaging application is sent to email recipients,***

wherein the group email message is stored in a common database such that the users in the predefined group of users have access to the group email message via the database.

***(Emphasis added).***

Applicants respectfully submit that claim 10, as amended, is allowable over the cited art for at least the reason that none of *Hickey*, *Heyen*, and *Friskel*, taken alone or in combination, discloses, teaches, or suggests a "communication method... ***wherein providing an interface includes providing a single user-selectable option for a user to select whether predetermined presence data for both the email application and the instant messaging application is sent to email recipients***" as recited in claim 10. More specifically, the Office Action admits "Hickey and Heyen disclose the claimed invention except for... wherein the system is configured to provide an interface that includes a single option to determine presence data for both the email application and the instant messaging application" (OA page 4, line 7).

Further, *Friskel* fails to overcome the deficiencies of *Hickey* and *Heyen*. More specifically, *Friskel* discloses a "sender status column 308 to indicate the on-line status of each sender of an e-mail using status indicators 310" (column 5, line 9). However, this deals with an indicator that is provided to an email recipient. Consequently, this is completely different than a

"communication method... ***wherein providing an interface includes providing a single user-selectable option for a user to select whether predetermined presence data for both the email application and the instant messaging application is sent to email recipients***" as recited in claim 10. For at least these reasons, claim 10, as amended, is allowable.

**C. Claim 13 is Allowable Over Hickey, Heyen, and Friskel**

The Office Action indicates that claim 13 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Publication Number 2002/0087646 ("*Hickey*") in view of U.S. Patent Number 5,093,918 ("*Heyen*"), and further in view of U.S. Patent Number 6,839,737 ("*Friskel*"). Applicants respectfully traverse this rejection for at least the reason that *Hickey* in view of *Heyen* and *Friskel* fail to disclose, teach, or suggest all of the elements of claim 13. More specifically, claim 13 recites:

A computer-readable storage medium that includes a computer program that, when executed by a computer, performs at least the following:

- providing indicators in a group email message, the group email message being provided to a predefined group of users, each indicator corresponding to one of the users in the predefined group of users, each indicator having a setting, each indicator configured to indicate whether the corresponding user has acted upon the group email message;

- changing the setting of one indicator in response to the email message being acted upon by its corresponding user; and

- providing, by an email application, an interface for providing the group email message and an option to view at least one user-specific email, the user-specific email being different than the group email message, the interface including an instant messaging interface for a common account as the email application, ***wherein providing an interface includes providing a single user-selectable option for a user to select whether predetermined presence data for both the email application and the instant messaging application is sent to email recipients,***

- wherein the group email message is stored in a common database such that the users in the predefined group of users have access to the group email message via the database.

***(Emphasis added).***

Applicants respectfully submit that claim 10, as amended, is allowable over the cited art for at least the reason that none of *Hickey*, *Heyen*, and *Friskel*, taken alone or in combination, discloses, teaches, or suggests a "computer-readable storage medium that includes a computer program... ***wherein providing an interface includes providing a single user-selectable option for a user to select whether predetermined presence data for both the email application and the instant messaging application is sent to email recipients***" as recited in claim 10. More specifically, the Office Action admits "Hickey and Heyen disclose the claimed invention except for... wherein the system is configured to provide an interface that includes a single option to determine presence data for both the email application and the instant messaging application" (OA page 4, line 7).

Further, *Friskel* fails to overcome the deficiencies of *Hickey* and *Heyen*. More specifically, *Friskel* discloses a "sender status column 308 to indicate the on-line status of each

sender of an e-mail using status indicators 310" (column 5, line 9). However, this deals with an indicator that is provided to an email recipient. Consequently, this is completely different than a "computer-readable storage medium that includes a computer program... ***wherein providing an interface includes providing a single user-selectable option for a user to select whether predetermined presence data for both the email application and the instant messaging application is sent to email recipients***" as recited in claim 10. For at least these reasons, claim 10, as amended, is allowable.

**D. Claims 2 – 7, 9, 11, 12, 14 – 18, and 20 are Allowable Over Hickey, Heyen, and Friskel**

The Office Action indicates that claims 2 – 7, 9, 11, 12, 14 – 18, and 20 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Publication Number 2002/0087646 ("*Hickey*") in view of U.S. Patent Number 5,093,918 ("*Heyen*"), and further in view of U.S. Patent Number 6,839,737 ("*Friskel*"). Applicants respectfully traverse this rejection for at least the reason that *Hickey* in view of *Heyen* and *Friskel* fail to disclose, teach, or suggest all of the elements of claims 2 – 7, 9, 11, 12, 14 – 18, and 20. More specifically, Applicants cancel claim 3. Further, dependent claims 2, 4 – 7, 9, and 20 are allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 1. Dependent claims 11 and 12 are allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 10. Further, dependent claims 14 – 18 are allowable for at least the reason that they depend from and include the elements of allowable independent claim 13. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

**E. Claims 8 and 19 are Allowable Over Hickey, Heyen, Friskel, and Stark**

The Office Action indicates that claims 8 and 19 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Publication Number 2002/0087646 ("*Hickey*") in view of U.S. Patent Number 5,093,918 ("*Heyen*"), and in view of U.S. Patent Number 6,839,737 ("*Friskel*"), and in further view of U.S. Publication Number 2003/0233420 ("*Stark*"). Applicants respectfully traverse this rejection for at least the reason that *Hickey* in view of *Heyen*, *Friskel* and *Stark* fail to disclose, teach, or suggest all of the elements of claims 8 and 19. More specifically, dependent claim 8 is allowable over *Hickey*, *Heyen*, and *Friskel* for at least the reason that this claim depends from and includes the elements of allowable independent claim 1. Further, dependent claim 19 is allowable over *Hickey*, *Heyen*, and *Friskel* for at least the reason that this claim depends from and includes the elements of allowable independent claim 13. Because *Stark* fails to overcome the deficiencies of *Hickey*, *Heyen*, and *Friskel*, claims 8 and 19 are allowable as a matter of law. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

## II. New Claim 21

In addition, Applicants add new claim 21. New claim 21 is allowable for at least the reason that this claim depends from allowable independent claim 1. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002). Support for this claim may be found (among other places) on page 29, line 12 and FIG. 9.



**CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, all objections and/or rejections have been traversed, rendered moot, and/or addressed, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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